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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants/
Applicants: FRYBERG et al.

Group Art Unit: 1774

Serial No.: 09/040,825

Examiner: M. Yamnitzky

Filed: March 18, 1998

Date: November 22, 2004

Title: RECORDING SHEETS FOR INK JET PRINTING

MAIL STOP APPEALS - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR REHEARING
APPEAL NO. 2004-1906**

Sir/Madame:

This is a Request for Rehearing of the Board of Patent Appeals and Interferences Decision mailed on September 20, 2004 relating to Appeal No. 2004-1906.

This request is timely filed today since it is being submitted within two months of the Board's decision (the date of November 20, 2004 fell on a Saturday).

Appellants believe there is no fee for filing this request.

BACKGROUND OF APPEAL

An Appeal Brief was filed by the Appellant on July 3, 2003 arguing that the Examiner's final rejection dated June 7, 2002, of all the claims remaining in the application, namely, claims 3, 4

and 6 to 13, as being indefinite and also, as being obvious over U.S. Patent No. 4,801,497 to Kono in view of U.S. Patent No. 5,281,307 to Smigo, was incorrect (A courtesy copy of the claims on appeal are attached as the Appendix).

The Examiner filed an Answer on October 8, 2003. No Reply Brief by the Appellant was filed.

REMARKS

The Boards Decision was based on the papers described above. The Decision reversed the indefiniteness rejection of claims 3, 4 and 6 to 13 under 35 U.S.C. § 112 ¶2.

However, the obviousness rejection of claims 3, 4 and 6 to 13 under 35 U.S.C. § 103(a) over Kono in view of Smigo was affirmed.

The Appellants request this rehearing directed only to the issue of the affirmation of the Examiner's rejection of claims 3, 4 and 6 to 13 as being obvious over Kono in view of Smigo.

The Appellants assert that the following points of law or fact were overlooked or misapprehended by the Board:

1. In the Decision at page 2 the Board incorrectly agreed with the Examiner that the claims 3, 4 and 6-13 on appeal did stand and fall together stating that the appellants did not provide any specific reasons for the separate patentability of any individual claim. Accordingly, they selected and reviewed only independent Claim 12, not independent Claim 13 which was of a different scope directed to a preferred embodiment claiming a single binder comprised of gelatin, nor any of the dependent claims.

Appellants direct the Board to the appellants Brief, at page 6 which states that "Claims 3, 4 and 6 to 12 (Group I) and claim 13 (Group II) are two separate groups of product claims defining separate embodiments of the invention and include different limitations."

Further at pages 6 to 8 of the Brief, the Appellant further describes the limitations of each of the dependent claims.

In view of such, the Appellants respectfully assert that the Board should have considered independent Claim 13, and dependent Claims 3, 4 and 6-11 separately from Claim 12, as the Appellant provided support that the rejected claims "do not stand or fall together".

2. Appellants argued that Kono does NOT teach a catPVA range between 75 to 99% by weight and in fact the Examples in Kono support only a range of 77-90% (Decision page 7).

Appellants assert that the Board incorrectly applied the catPVA range of Kono as being 75 to 99% by weight, which is a range beyond the teaching of its examples. Appellant argued that the Kono reference only has support for a catPVA range of 77 to 90% as set forth in the examples.

Kono provides insufficient disclosure for teaching a range of 75 to 99% by weight (see *In re Borkowski* 422 F2d 904, 164 USPQ 642 (CCPA 1970)).

The Appellant's claims define the catPVA copolymer as between 10 to 75 weight% of the combined amount of the copolymer and binder, which is below the range taught by Kono.

3. Appellants argued that Kono does not teach the binder system used in the invention. The Board incorrectly held that Kono discloses the same binder system (Decision page 9).

The Board supports the Examiner's assertion that Kono discloses gelatin, which is the same binder as preferred by appellants (Answer, page 7). Appellants believe the Board unintentionally mislead and misapplied this statement which must be read within the proper text of the reference.

In fact, Kono teaches use of a catPVA, together with Polymer-A, and **optionally**, a binder which could be gelatin (Kono Col. 7, lines 35-53).

In contrast, the invention claim 13 defines the use of a catPVA polymer and a **single** binder of gelatin.

The invention claim 12 defines the use of a catPVA polymer and a binder or mixture of binders. The binders of claim 12 are defined in dependent claims 6 and 7 (Brief, page 7).

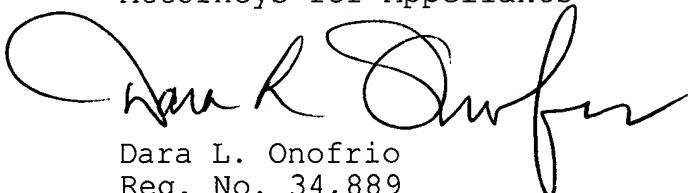
Thus, the invention binder system is distinct from that disclosed in the Kono reference.

SUMMARY

It is thus respectfully requested that the rehearing be directed to the points addressed above. Appellants believe that the affirmation of the obviousness rejection of claims 3, 4 and 6 to 13 be reversed. It is believed the application and the claims are in condition for allowance.

Respectfully submitted,

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APPENDIX

3. A recording sheet for ink jet printing according to claim 12 wherein said layer forms a film.

4. A recording sheet for ink jet printing according to claim 12 wherein said layer further contains a crosslinking agent.

6. A recording sheet according to claim 12 wherein said binder or binders are selected from the group consisting of polyvinyl alcohol, gelatine, starch, carboxymethyl cellulose, hydroxyethyl cellulose, hydroxypropyl cellulose, hydroxymethyl cellulose, methoxyethyl cellulose, gum arabic, polyvinyl pyrrolidone, polyvinyl-methyl pyrrolidone and casein.

7. A recording sheet according to claim 12 wherein said binder or binders are selected from the group consisting of polymers or copolymers derived from acrylic acid and esters of acrylic acid.

8. A recording sheet according to claim 4 wherein said crosslinking agent is selected from the group consisting of triazine derivatives, epoxides, aldehydes, vinyl sulfones and carbamoyl derivatives.

9. A recording sheet according to claim 4 wherein said crosslinking agent is selected from the group consisting of triazine derivatives and, carbamoyl derivatives.

10. A recording sheet according to claim 4 wherein said crosslinking agent is hydroxy-dichloro-1, 3, 5-triazine or 2-(4-dimethylcarbamoyl-pyridino)-ethane-sulfonic acid.

11. A recording sheet according to claim 12 where R is H or CH₃.

12. A recording sheet for ink jet printing comprising a support coated with at least one layer receptive for aqueous inks; wherein said layer contains:

(a) at least one copolymer of the general structure:

where

R = H or alkyl with 1-6 carbon atoms

x + y = 1

y = 0.05 - 0.2

$x = 0.8 - 0.95$; and

(b) a binder or mixture of binders;
(c) wherein the quantity of said copolymer is between 10 to 75 weight % of the combined amount of said copolymer and binder and said layer provides the sheet with enhanced light fastness properties.

13. A recording sheet for ink jet printing comprising a support coated with at least one layer receptive for aqueous inks; wherein said layer comprises:

(a) at least one copolymer of the general structure:

where

$R = H$ or alkyl with 1-6 carbon atoms

$x + y = 1$

$y = 0.05 - 0.2$

$x = 0.8 - 0.95$; and

(b) a binder comprised of gelatin;
(c) wherein the quantity of said copolymer is between 10 to

75 weight % of the combined amount of said copolymer and binder and said layer provides the sheet with enhanced light fastness properties.